

Appln. No. 10/674,228
Reply to Office action of April 6, 2005
Response dated June 6, 2005

REMARKS

The Examiner has issued a restriction requirement stating that the application allegedly contains claims that are directed to the following patentably distinct inventions:

- I. Claims 1-4 drawn to method of identifying proteins that induces autoantibodies, classified in class 435, subclass 7.1.
- II. Claims 5-14, drawn to method of cancer diagnosis by detecting autoantibodies specific for a beta-tubulin isoforms or yet to be identified protein, classified in class 435, subclass 7.23.
- III. Claims 15-17, drawn to method of stimulating an immune response to a beta-tubulin isoforms or yet to be identified protein, classified in class 424, subclass 184.1.
- IV. Claim 18, drawn to composition comprising a yet to be identified protein, classified in class 530, subclass 350.
- V. Claims 19-21, drawn to composition comprising an antibody binding to a protein yet to be identified by the method described in claim 1, classified in class 530, subclass 387.1.

However, Applicants respectfully point out that during examination of U.S. Patent Application 09/464,840, now issued as U.S. Patent No. 6,677,128, which is the parent application of the present invention, the Examiner issued a restriction requirement in which the same claims were grouped into only four species: (i) claims 1-4

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and 10-14, drawn to methods of identifying proteins and methods of diagnosis for the presence of cancer; (ii) claims 5-9, drawn to methods of diagnosis and prognosis of cancer comprising detecting auto antibodies; (iii) claims 15-17, drawn to methods of stimulating in a subject an immune response; and (iv) claims 18-21, drawn to compositions comprising a protein identified in the method of claim 1. (See Office Communication mailed November 22, 2000, attached herewith). Therefore, the Examiner determined that each group of claims comprises a single distinct invention. In response, Applicants elected to prosecute claims 5-9, which have now issued as U.S. Patent No. 6,677,128. Applicants therefore respectfully submit that the claims of the present invention should be grouped according to the Office Communication previously issued in U.S. Patent Application 09/464,840. Indeed, because claims 1-4 drawn to methods of identifying proteins and claims 10-14 drawn to methods of diagnosis for the presence of cancer comprising detecting the expression of a protein identified using the method of claim 1 are clearly related these claims should be grouped together. Applicants therefore respectfully request withdrawal of the restriction requirement and consideration of claims 1-4 and 10-14 in the present application.


Although Applicants respectfully traverse the restriction requirement, claims 1-4 corresponding to Group I are provisionally elected, as required under 37 C.F.R. 1.143, without prejudice to the prosecution of subject matter of non-elected claims in other patent applications.

Payment of the extension fee is to be made according to the Credit Card Payment Form attached herewith. Applicants believe that no additional fees are required

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in connection with this response. However, if additional fees are required, the
Commissioner is hereby authorized to charge any additional payment, or credit any
overpayment, to Deposit Account No. 01-2300, referencing Docket Number
108140.00015.

Respectfully submitted,



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Enclosure